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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/909,117	08/11/97	MORANDO	J MJV106BCON

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IM22/1222

EXAMINER

YEE, D

ART UNIT	PAPER NUMBER
1742	14

DATE MAILED: 12/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/909117Applicant(s)
MorandoExaminer
LeeGroup Art Unit
1742

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on 10-12-99.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 2 to 12, 34 to 38, 42 to 45 and 47 to 50 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 2 to 12, 34 to 38, 42 to 45, + 47 to 50 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 12 (7-12-99) Interview Summary, PTO-413
- Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Response to Amendment

1. The amendment of paper no. 13 dated October 21, 1999 directed to adding an abstract as new page 42 has not been entered. Applicant needs to submit abstract on a new separate page numbered 42 to be entered.

Response to Arguments

2. Applicant's arguments and 1.132 declaration filed October 21, 1999 have been fully considered and are deemed persuasive over the 103 rejection based on Way et al (US Patent No. 4,034,588).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2 to 12, 34 to 38, 42 to 45 and 47 to 50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 49 and 50 recite "Chromium 15-30" and "Molybdenum 2-8", and claim 50 recites "Boron >0 to <50" , and claim

49 recites "Tungsten 10-30" and "Iron 10-50" which clearly raise new matter issues since no clear descriptive support exists for these broader generic ranges in the original disclosure; see pages 23 and 24 of applicant's specification wherein more narrow ranges are disclosed, "15<Cr<30", "2<Mo<8", "0< B<5.0", "10<Fe<50" and "10<W<30"

5. Claims 3 to 12, 34 to 38, 42 to 45 and 47 to 50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an article of equipment comprising an alloy material comprising alloying constituents with specific wt% ranges, as evident by pages 23 to 25 of the specification, does not reasonably provide enablement for an alloy material comprising alloying constituents with no specified amount, e.g. carbon recited in claim 50 and vanadium, niobium, cobalt, boron and manganese recited in claim 49. Hence claims are of a breadth which are not adequately supported by its specification. See *In re Borkowski et al*, 164 USPQ642. Also note that the fact that the terms in a claim are the same as those in the specification does not prevent the claim from being unduly broad if they define subject matter not described to be the actual invention by means of adequate representative examples. See *Ex parte Gardner* 157USPQ642; and *In re Cavalito et al*, 127 USPQ 202.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claims are undefined because there is no weight percent range for carbon, vanadium, niobium, cobalt, boron and manganese.

Double Patenting

8. Claims 1 and 34 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 4, 12, respectively. Also claim 1 is a duplicate of claims 7, 8, 9 and 42. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

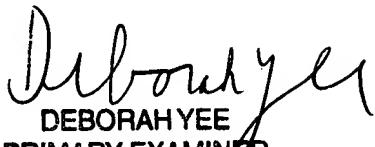
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is (703) 308-1102.



DEBORAH YEE
PRIMARY EXAMINER

dy

December 20, 1999